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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/717,856

11/19/2003

Eric Mics

V8998-6

9502

7590

08/14/2006

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EXAMINER

HOFFMANN, JOHN M

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 08/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/717,856

Applicant(s)

MICS ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 11-16 and 15, 4, 14, 16 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okude alone, or in view of O'Toole 6336749.

See the prior Office actions for the manner in which the limitations are taught by, or would have been obvious in view of, the references.

As to the new limitation that the fiber is adapted to be spliced. This is inherently met – substantially anything can be spliced/joined with anything else. The splicing is an intended use that fails to impart any limitation that defines over the prior art.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 7-10, 17-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okude alone, or in view of Ueda 5372623.

See above and the prior Office actions.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okude alone, or in view of Ueda 5372623 and O'Toole 6336749.

See above and the prior Office actions.

Claims 1- 3, 5, 11-13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato 6729777.

See how Kato is applied in previous office action(s). Again, the adapted to be spliced limitation is inherently met by Kato, because it can be spliced to substantially anything. Or to put it another way: it is impossible to have a fiber which cannot be spliced to another fiber having a larger mode field diameter.

Claims 4, 6, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato alone, or in view of O'Toole 6336749.

See above and the prior Office action.

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Claims 7-10, 17-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato alone, or in view of Ueda 5372623.

See above and the prior Office action.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okude alone, or in view of Ueda 5372623 and O'Toole 6336749.

See the reasons given above.

### ***Response to Arguments***

Applicant's arguments filed have been fully considered but they are not persuasive.

It is argued that the claimed feature of heating a free end of a fiber has certain unexpected benefits. It appears that Applicant is suggesting that Applicant is asserting secondary considerations which overcome the Office's prima facie showing of obviousness. This is not persuasive. Applicant has not set forth what those certain unexpected benefits are, nor is there any evidence to support the assertion. Arguments cannot take the place of evidence where evidence is needed. Furthermore, mere unexpected results are insufficient. The results would have to be both new and unexpected.

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It is further argued that Okude does not describe or provide motivation for the fiber being adapted to be spliced as claimed.

From MPEP 2112: "The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103." Thus a rejection under 35 USC 103 can still be proper even though the adaptation to splice is not expressly taught.

#### **From MPEP 2145**

#### **II. ARGUING ADDITIONAL ADVANTAGES OR LATENT PROPERTIES**

**Prima Facie Obviousness Is Not Rebutted by Merely Recognizing Additional Advantages or Latent Properties Present in the Prior Art**

Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. In re Wiseman, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (Claims were directed to grooved carbon disc brakes wherein the grooves were provided to vent steam or vapor during a braking action. A prior art reference taught noncarbon disc brakes which were grooved for the purpose of cooling the faces of the braking members and eliminating dust. The court held the prior art references when combined would overcome the problems of dust and overheating solved by the prior art and would inherently overcome the steam or vapor cause of the problem relied upon for patentability by applicants. Granting a patent on the discovery of an unknown but inherent function (here venting steam or vapor) "would re-move from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art." 596 F.2d at 1022, 201 USPQ at 661.); In re Baxter Travenol Labs., 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) (Appellant argued that the presence of DEHP as the plasticizer in a blood collection bag unexpectedly suppressed hemolysis and therefore rebutted any prima facie showing of obviousness, however the closest prior art utilizing a DEHP plasticized blood collection bag inherently achieved same result, although this fact was unknown in the prior art.).

"The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.). See also Lantech Inc. v. Kaufman Co. of Ohio Inc., 878 F.2d 1446, 12 USPQ2d 1076, 1077 (Fed. Cir. 1989), cert. denied, 493 U.S. 1058 (1990) (unpublished — not citable as precedent) ("The recitation of an additional advantage associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention.").

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In re Lintner, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) and In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) discussed in MPEP § 2144 are also pertinent to this issue.

For the same above reasons, Examiner is not persuaded by Applicant's arguments that Kato does not describe the "adapted..." limitation.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus it does not matter that O'Toole (alone) does not teach each of the claim limitations: The rejection is not based on O'Toole alone. The same applies to the Ueda arguments.

It is also argued that Kato does not teach, suggest or provide motivation for the present invention. This is not persuasive – because it is largely irrelevant – the rejection is not based on any assertion that Kato teaches, suggests or provides motivation for the entire invention. Kato teaches almost everything: that which Kato does not teach would have been obvious for the reasons set forth in the rejection – refer to the rejection. Since applicant fails to disagree with the Office's finding that those feature would have been obvious as set forth in the rejection – it is deemed that Applicant completely agrees that it would have been obvious.

The assertion of a “new and advantageous use of an organic liquid-fueled flame” is noted. However, such appears to be no consequence. Applicant has not pointed out to how this is relevant to the question of obviousness – nor is Examiner aware of any relevance. It is deemed that since applicant has not asserted that the use has no new and unexpected result, and provided evidence thereof, that there is no such result known by applicant.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.



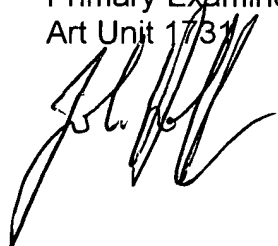
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Hoffmann  
Primary Examiner  
Art Unit 1731

jmh



8-11-06